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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,241	12/12/2003	Hisaya Suzuki	246459US90	9463

22850 7590 09/29/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

SZUMNY, JONATHAN A

ART UNIT PAPER NUMBER

3632

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,241

Applicant(s)

SUZUKI ET AL.

Examiner

Jon A Szumny

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 3-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT-Rule-17-2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/12/03 & 4/29/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

This is the second office action for application number 10/733,241, Outer Mirror Assembly, filed on December 12, 2003.

Election/Restrictions

Applicant's election with traverse of Species I corresponding to claims 1 and 2 in the reply filed on July 19, 2004 is acknowledged. The traversal is on the ground(s) that a search and examination of the entire application would not be a serious burden on the Examiner.

This is not found persuasive. It is noted that the applicant did not deny that the species as laid out by the Examiner are distinct. Further, the mere fact that there are eleven distinct species would place a serious burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claims 3-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 19, 2004.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

Receipt is acknowledged of each Form PTO-1449, Information Disclosure Statement, which have been reviewed by the Examiner.

Specification

The disclosure is objected to because of the following informalities:

On page 16, line 8, "toward backward" should be --backwardly--;

On page 18, lines 9-10, it is not understood what is meant by "connected to that (not shown) of the vehicle body VB.";

On page 19, line 26, it is not understood what is meant by "able to have view for the side".

Appropriate correction is required.

Claim Objections

Claim 2 is objected to because of the following informalities:

In line 1, "An" should be --The--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear if the applicant is claiming the sub-combination of an outer mirror assembly *for* a vehicle, or the combination of the outer mirror assembly *and* a vehicle. The preamble of claim 1 states the former (note clause "for"), but then the combination is claimed in line 2 ("...a mirror base extending outwardly from a side of a vehicle body"), lines 3-4 ("...so that a space between the vehicle body and the mirror can be provided..."), and in claim 2, lines 2-3, ("...which is attached to a forward end of a side window of the vehicle body.") Further, "can be" is confusing. Is the "space" provided or not provided? The applicant must make it clear whether the combination or sub-combination is claimed as the invention. For instance, utilizing the phrase *--adapted to--* would claim the sub-combination. For the purposes of this office action, the sub-combination will be assumed the invention.

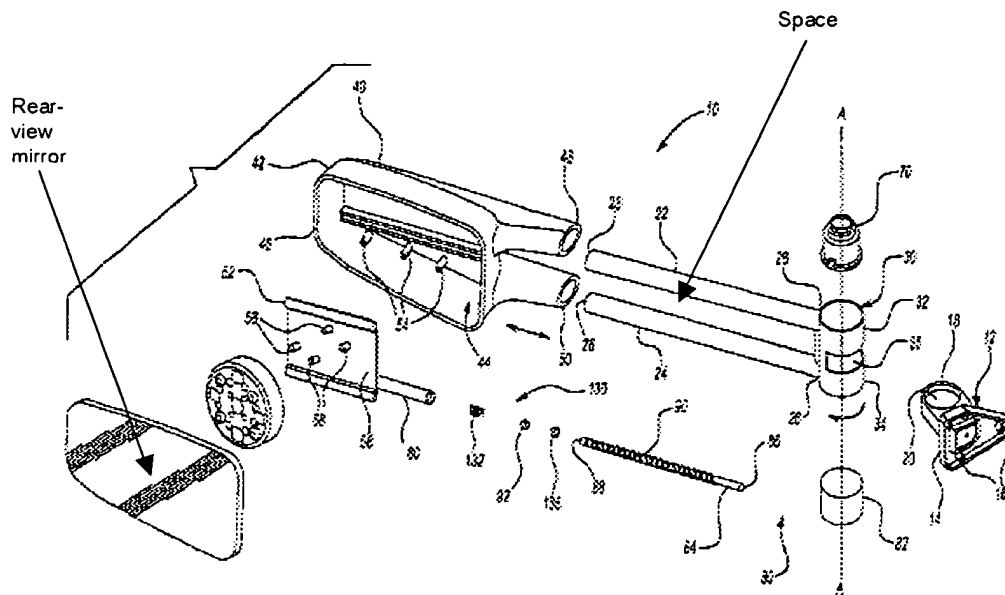
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent number 6,439,730 to Foote et al.



Foote et al. '730 discloses an outer mirror assembly (figure 1) comprising a mirror base (22,24,30) inherently adapted to extend outwardly from a side of a vehicle body, a mirror housing (40) suspended from the mirror base so that a space (above) inherently could provided between the vehicle body and the mirror housing, and a rear view mirror (above) disposed in the mirror housing, wherein the mirror base comprises a mounting plate (14) which inherently could be attached to a forward end of a side window of the vehicle body.

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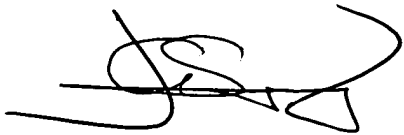
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hoek '743, Hayashi et al. '554, Shinohara '139 and Kuo '501 disclose various outer mirror assemblies.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon A Szumny whose telephone number is (703) 306-3403. The examiner can normally be reached on Monday-Friday 8-4.

The fax phone number for the organization where this application and proceeding are assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to be 'JSZ', with a large, sweeping flourish extending to the right.

Jon Szumny
Patent Examiner
Technology Center 3600
Art Unit 3632
September 21, 2004